

REMARKS

This communication is in response to the final Office Action issued October 16, 2002. The Examiner rejected claims 1, 19, and 21 under 35 U.S.C. § 102 in view of U.S. Patent No. 6,307,853 to Storch *et al.* (Storch). The Examiner rejected claims 2-4, 6-18, 20, and 23-31 under 35 U.S.C. § 103 in view of Storch modified by one or more of U.S. Patent Nos. 5,654,957 to Koyama (Koyama) and 5,726,984 to Kubler *et al.* (Kubler).

Interview

The Applicant thanks the Examiner for conducting a personal interview on November 26, 2002. During the interview, the Examiner and the Applicant agreed that the Storch reference does not disclose a telephone to packet adapter for use with a user's home telephone line.

Attorney Docket Number

The Applicants submitted a Revocation and Power of Attorney on October 31, 2001 indicating the change in representation and attorney docket number for this application. The Applicants submitted another copy of the Revocation and Power of Attorney on July 22, 2002. A Notice Regarding Power of Attorney, mailed on July 31, 2002, indicated that the Revocation and Power of Attorney was accepted. The Office Action, however, still indicates the previous attorney docket number. The Applicants respectfully request that the attorney docket number be changed from GGD-101 to 20014.0002.

Claim Rejections Under 35 U.S.C. § 102

In sections 2-3 of the Office Action, the Examiner rejected claims 1, 19, and 21 under 35 U.S.C. § 102 in view of Storch.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of claims 1, 19, and 21 do not satisfy this burden.

During the November 26, 2002 interview, the Applicant and the Examiner agreed that the Storch reference, which requires the presence of a private branch exchange (PBX) to work, does not disclose a telephone to packet adapter for use with a user's home telephone line. As stated at pages 2-3 of the July 22, 2002 Response, the present invention discloses and claims a "telephone to packet adapter" (not a telephony system including a PBX) or a method of using such an adapter. Because the adapter itself determines which calls are connected through the standard telephone line and which calls are connected through the packet network, the adapter allows a caller to be connected through a telephone line or through a packet network without requiring the presence of a PBX. This is advantageous for environments that are not equipped with a PBX, such as a user's home.

To more clearly differentiate the present invention from the Storch device, the Applicant has amended the independent claims above to recite that the adapter has a telephone line interface that is configured to be connected to a *user's home telephone line*, as discussed during the November 26 interview. Support for the added recitation is seen, for example, at page 16 lines 24-27.

In view of the foregoing, the Examiner's rejection under 35 U.S.C. § 102 to claims 1, 19, and 21 is believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103

In sections 4-6 of the Office Action, the Examiner rejected claims 2-4, 6-18, 20, and 23-31 under 35 U.S.C. § 103 in view of Storch modified by one or more of Koyama and Kubler. Specifically, the Examiner rejected claims 2-4, 10-13, 18, 20, and 26-28 in view of Storch modified by Koyama, and claims 6-9, 14-17, 23-25, and 29-31 in view of Storch modified by Koyama and Kubler.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of claims 2-4, 6-18, 20, and 23-31 do not satisfy these burdens.

As discussed above, Storch does not disclose or suggest all of the recitations of the independent claims. As discussed in the November 26 interview, neither Koyama nor Kubler satisfy the shortcomings of Storch. Therefore, the rejections of claims 2-4, 6-18, 20, and 23-31 are improper and must be withdrawn.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 103 to claims 2-4, 6-18, 20, and 23-31 are believed to be overcome.

New Reference

During the November 26 interview, the Examiner provided a paper by Foo *et al.* (the Foo reference). In keeping with the Applicant's duty of disclosure requirements, an information disclosure statement disclosing this paper is included herewith. However, this disclosure should not be interpreted as an admission that the Foo reference is prior art. The Examiner has made no showing that 1) the paper was ever published, and 2) the date of the paper predates the application's earliest effective filing date.

Additional Fees

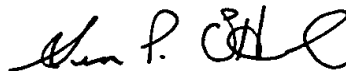
The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 20014.0002).

Conclusion

Claims 1, 6, 8, 9, 11, 19, 23, 25, and 26 have been amended. Claims 1-4, 6-21, and 23-31 are pending in the application. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner

feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



Dated: 12/16/02

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APPENDIX A:

MARKED-UP COPY OF THE AMENDED CLAIMS

1 1. (Thrice Amended) A telephone to packet adapter for routing an outgoing call issued
2 by a telephone set in a user's home, said adapter comprising:

3 a telephone line interface configured to be connected to a user's home telephone line;

4 a telephone interface configured to be connected to the telephone set;

5 a packet network interface configured to be connected to a packet network;

6 a controller circuit interconnecting said telephone line interface, said telephone
7 interface and said packet network interface;

8 said controller circuit being so configured as to route said outgoing call to one of said
9 telephone line and said packet network interfaces depending on at least one preestablished
10 routing rule;

11 wherein said at least one preestablished routing rule is such that a) said outgoing call is
12 routed to said telephone line interface when a dialled telephone number is a local call and b)
13 said outgoing call is routed to said packet network interface when the dialled telephone
14 number is not a local call.

1 6. (Thrice Amended) A telephone to packet adapter for routing an outgoing call issued
2 by a telephone set in a user's home, said adapter comprising:
3 a telephone line interface configured to be connected to a user's home telephone line;
4 a telephone interface configured to be connected to the telephone set;
5 a packet network interface configured to be connected to a packet network;
6 a controller circuit interconnecting said telephone line interface, said telephone
7 interface and said packet network interface;
8 said controller circuit being so configured as to route said outgoing call to one of said
9 telephone line and said packet network interfaces depending on at least one preestablished
10 routing rule;
11 wherein said at least one preestablished routing rule is such that said outgoing call is
12 routed to said telephone line interface when no packet network address corresponding to a
13 dialled telephone number exist.

1 8. (Thrice Amended) A telephone to packet adapter for routing an outgoing call issued
2 by a telephone set in a user's home, said adapter comprising:

3 a telephone line interface configured to be connected to a user's home telephone line;

4 a telephone interface configured to be connected to the telephone set;

5 a packet network interface configured to be connected to a packet network;

6 a controller circuit interconnecting said telephone line interface, said telephone
7 interface and said packet network interface;

8 wherein said controller circuit includes a telephone number database of telephone
9 numbers that may be reached via the packet network; said at least one preestablished routing
10 rule is such that a) said outgoing call is routed to said telephone line interface when a dialled
11 telephone number is not present in said telephone number database and b) said outgoing call is
12 routed to said packet network interface when the dialled telephone number is listed in said
13 telephone number database.

1 9. (Thrice Amended) A telephone to packet adapter for routing an outgoing call issued
2 by a telephone set in a user's home, said adapter comprising:

3 a telephone line interface configured to be connected to a user's home telephone line;

4 a telephone interface configured to be connected to the telephone set;

5 a packet network interface configured to be connected to a packet network;

6 a controller circuit interconnecting said telephone line interface, said telephone
7 interface and said packet network interface;

8 wherein said at least one preestablished routing rule is such that said outgoing call is
9 routed to said telephone line interface when said packet network is inactive.

1 11. (Amended) A telephone to packet adapter comprising:
2 a telephone line interface configured to be connected to a user's home telephone line;
3 a telephone interface configured to be connected to a telephone set;
4 a Local Area Network interface configured to be connected to a Local Area Network;
5 a packet network interface configured to be connected to a packet network; and
6 a controller circuit interconnecting said telephone line interface, said telephone
7 interface, said Local Area Network interface and said packet network interface; said controller
8 circuit being so configured as to either a) route said telephone interface to one of said
9 telephone line and said packet network interfaces and b) route said Local Area Network
10 interface to one of said telephone line and said packet network interfaces, depending on at
11 least one preestablished routing rule.

1 19. (Thrice Amended) A method for routing a telephone call issued by a telephone set in a
2 user's home via a telephone to packet adapter provided with a telephone line interface, a
3 telephone interface, a packet network interface and a controller circuit interconnecting the
4 telephone line, telephone and packet network interfaces; said method comprising the steps of:
5 connecting a user's home telephone line to the telephone line interface;
6 connecting the telephone set to the telephone interface;
7 connecting the adapter to a packet network via the packet network interface;
8 running an agent software for routing the telephone call to either the telephone line
9 interface or the packet network interface depending on at least one preestablished routing rule;
10 wherein said at least one preestablished routing rule includes a long distance call
11 routing rule; said long distance call routing rule dictates that the telephone interface is to be
12 routed to the packet network interface when a number dialled onto the telephone set is a long
13 distance call.

1 23. (Thrice Amended) A method for routing a telephone call issued by a telephone set in a
2 user's home via a telephone to packet adapter provided with a telephone line interface, a
3 telephone interface, a packet network interface and a controller circuit interconnecting the
4 telephone line, telephone and packet network interfaces; said method comprising the steps of:
5 connecting a user's home telephone line to the telephone line interface;
6 connecting the telephone set to the telephone interface;
7 connecting the adapter to a packet network via the packet network interface;
8 running an agent software for routing the telephone call to either the telephone line
9 interface or the packet network interface depending on at least one preestablished routing rule;
10 wherein said at least one preestablished routing rule includes a default routing rule;
11 said default routing rule dictates that the telephone interface is to be routed to the telephone
12 line interface when either a) a number dialled onto the telephone set has no corresponding
13 packet network address or b) the packet network is inactive.

1 25. (Thrice Amended) A method for routing a telephone call issued by a telephone set in a
2 user's home via a telephone to packet adapter provided with a telephone line interface, a
3 telephone interface, a packet network interface and a controller circuit interconnecting the
4 telephone line, telephone and packet network interfaces; said method comprising the steps of:
5 connecting a user's home telephone line to the telephone line interface;
6 connecting the telephone set to the telephone interface;
7 connecting the adapter to a packet network via the packet network interface;
8 running an agent software for routing the telephone call to either the telephone line
9 interface or the packet network interface depending on at least one preestablished routing rule;
10 wherein said at least one preestablished routing rule includes a database determined
11 routing rule; said database determined routing rule dictates that a) the telephone interface is
12 routed to the packet network interface when a number dialled onto the telephone set is present
13 in a database of the controller circuit; and b) the telephone interface is routed to the telephone
14 line interface when a number dialled onto the telephone set is not present in the database.

1 26. (Twice Amended) A method for routing outgoing telephone calls to a packet network
2 via a telephone to packet adapter provided with a telephone line interface, a telephone
3 interface, a Local Area Network interface, a packet network interface and a controller circuit
4 interconnecting the telephone line, telephone, packet network and Local Area Network
5 interfaces; said method comprising the steps of:

6 connecting a user's home telephone line to the telephone line interface;

7 connecting a telephone set to the telephone interface;

8 connecting a Local Area Network to the Local Area Network interface;

9 connecting a packet network interface to the packet network interface;

10 running an agent software for routing either a) the telephone interface to one of the
11 telephone line interface and the packet network interface, or b) the Local Area Network
12 interface to one of the telephone line interface and the packet network interface, depending on
13 at least one preestablished routing rule.